

REMARKS

The Office Action has been carefully considered. Claims 30-35 are pending in the present application. Claims 36-66 are withdrawn, with traverse, as stated below. Claim 30 has been amended to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Support for the amendment may be found in the originally-filed application, *inter alia*, at page 3, lines 5-6; and in Figs. 1D, 2D and 2E. No new matter has been introduced.

Reconsideration of the present application in view of the amendment and the following remarks are respectfully requested.

I. RESTRICTION REQUIREMENT

The Examiner alleged that claims 36-66 submitted in the August 9, 2004 amendment are directed to an invention that is independent or distinct from the invention originally claimed. Claims 30-35 are directed to a medical device and claims 36-66 are directed to a method of manufacturing a medical device. The Examiner stated that since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. The Examiner has withdrawn claims 36-66 from consideration as being directed to a non-elected invention. Applicant respectfully traverses the restriction requirement and assert that even assuming, *arguendo*, that claims 30-35 and claims 36-66 represent distinct or independent inventions, to search and examine the subject matter of all the claims together would not be a serious burden on the Examiner. It is noted that M.P.E.P. § 811(Eighth Edition August 2001, Latest Revision May 2004) states that: "Before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." In addition, M.P.E.P. § 803 states that: "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."

Applicants respectfully assert that the subject matter of claims 30-35 and claims 36-66 are so intertwined that a single search would identify any relevant art pertaining to a medical device and a method of making such medical device. It is respectfully submitted that the subject matter of claims 30-35 and claims 36-66 should be searched and examined in the subject application as it would not be a serious burden. Accordingly, Applicant

respectfully requests under 37 U.S.C. §1.143 that the restriction requirement be reconsidered and withdrawn or modified such that the subject matter of claims 30-35 and 36-66 are examined in one application.

In order to be fully responsive, however, Applicant hereby elects to prosecute claims 30-35, with traverse, without prejudice to Applicant's rights to pursue the non-elected subject matter in one or more related applications.

II. CLAIMS 30-35 ARE PATENTABLE OVER RAGHEB

Claims 30-35 have been rejected under 35 U.S.C. §102(b) as allegedly being anticipated by United States Patent No. 6,096,070 to Ragheb *et al.* ("Ragheb"). This rejection is respectfully traversed.

Independent claim 30 recites a medical device having a coated tube-like portion comprising at least one laser-ablated opening extending through the coated portion. The opening is formed by ablating a coated structure with a laser. Claims 31-35 depend from claim 30 and, thus, also include the recitations of claim 30.

Ragheb does not disclose or suggest a laser-ablated opening extending through the coated portion of the medical device as recited in the present claims. In contrast, as shown in Figs. 1D, 2D and 2E in the present specification, in the present invention the ablated opening extends through the ablated structure. At most, Ragheb teaches a medical device that has a base material where holes, wells, slots, grooves and the like are formed in the surface of the device by utilizing lasers (col. 16, lines 58-63). When such apertures are formed in Ragheb, they do not extend through the ablated base material as shown in Fig. 10A-D of Ragheb. Rather, Ragheb teaches that the apertures are used for containing bioactive material (col. 16, lines 36-38). In order for the apertures to contain the bioactive material, the apertures do not extend through the base material (Fig. 10A-D). Accordingly, Ragheb teaches away from openings that extend through a coated portion of a medical device.

Although Ragheb teaches the use of lasers for cutting the surface of the device (col. 16, line 58-63), Ragheb does not disclose or suggest ablating a coated structure with a laser to form at least one opening extending through the coated portion as presently claimed.

According to MPEP § 2113, "[t]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where . . . the manufacturing process steps would be expected to impart

distinctive structural characteristics to the final product.” As stated in the present specification, the “polymer coating, when applied by methods in the art, tends to create bridges at small gaps or corners between stent struts. Also, in the conventional methods, wherein a coating process takes place after a shaping process, it is almost impossible to selectively coat the stent. For example, it is impossible to coat one side of a stent without coating the other side or to apply different coatings to the outside and inside of a stent.” Present specification, page 1, line 32, to page 2, line 1. In contrast, “medical devices having multiple coating layers and a complicated geometry pattern can also be easily manufactured by the method of the present invention without flaws such as polymer-bridges at gaps or corners.” Specification, page 9, lines 21-23. Thus, the resultant medical device of Ragheb would not be the same as that presently claimed.

Accordingly, Ragheb does not teach or suggest a medical device made by a process wherein a coating material and the structure covered by such material are ablated together by a laser as in the present invention.

Therefore, since Ragheb does not disclose or suggest each and every element of claims 30-35, Applicant respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(b) and allowance of claims 30-35.

III. CONCLUSION

As the claim rejection has been overcome, all pending claims are believed to be in condition for allowance. Should the Examiner not agree with Applicant's position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the allowance of the application.

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Respectfully submitted,

Gidon D. Stern

Gidon D. Stern

27,469

(Reg. No.)

Linda B. Azrin Reg. No. 44,516

By: Linda B. Azrin

(Reg. No.)

JONES DAY

222 East 41st Street

New York, N.Y. 10017

212-326-3939

Enclosures